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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/074,729	04/23/2002	Nipun Marwah	CHR 99-9 DIV	8074

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MEADWESTVACO CORPORATION
REGIONAL OFFICE BUILDING
PO BOX 118005
CHARLESTON, SC 29423-8005

EXAMINER

CHORBAJI, MONZER R

ART UNIT	PAPER NUMBER
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1744

DATE MAILED: 08/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/074,729

Applicant(s)

MARWAH ET AL.

Examiner

MONZER R. CHORBAJI

Art Unit

1744

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 April 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 April 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

This general action is in response to the application filing date of 04/23/2002

Remarks

1. On 08/12/2005 the examiner of record telephoned Terry B. McDaniel to verify whether to examine claims 1-9; however, Mr. McDaniel indicated that claims 1-9 have been cancelled and to only examine instant claims 10-17.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

3. Claim 17 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 17, line 2; applicant recites the following phrase "which forms the layer positioned immediately below the topmost layer." Is the applicant is referring to the sub-surface layer? Explanation and rewording of claim 17 is needed to understand the meaning of the claim. For purposes of examination, the examiner considers such a phrase as referring to the sub-surface layer.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 10-11 and 15-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Howard (U.S.P.N. 2,593,146).

With respect to claim 10, the Howard reference teaches a method of preparing paperboard (col.1, lines 1-5) produced from pulp stock (col.2, lines 17-18) and useful in paper based packages or containers (col.1, lines 1-3). The Howard reference teaches two approaches to include activated carbon (i.e., an adsorbent material), either mix the activated carbon with the pulp or applied it on the pulp (col.2, lines 8-10, col.2, lines 26-41). Applying the adsorbent on the pulp means forming a layer made of activated carbon on the upper surface of the pulp sheet. In addition, the Howard reference teaches applying the activated carbon material between sheets of paper such that a sub-surface layer (col.2, lines 33-36) of the adsorbent is formed within the paperboard.

With respect to claim 11, the Howard reference is in the production of, for example, containers made of paper or similar materials from which odors or vapors emanate (col.1, lines 1-8). The activated carbon adsorbs such odors or vapors and is inherently capable of adsorbing undesired odors from polymer and pigment-based additives employed in the making of packaging or container products.

With respect to claim 15, one of the approaches the Howard reference teaches for incorporating activated carbon is to mix it with the pulp material (col.2, lines 8-16). Thus, resulting in a single layer made up of pulp and activated carbon.

With respect to claims 16-17, the Howard reference teaches applying the activated carbon between sheets (col.2, lines 29-32) such that the result is multiple

layers structure where the top layer is made up of impervious paper (col.2, lines 38-41) and the sub-layer is made up of activated carbon.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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9. Claims 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Howard (U.S.P.N. 2,593,146) as applied to claim 10 and further in view of De Ceuster et al (U.S.P.N. 4,381,969).

With respect to claims 12-13, the Howard reference fails to teach adding the adsorbent in combination with hydrogen peroxide; however, the De Ceuster reference, which is in the art of treating paper materials, teaches adding hydrogen peroxide to pulp material (col.1, lines 65-68 and col.2, lines 17-21). Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of the Howard reference by including addition of hydrogen peroxide to pulp material as taught by the De Ceuster reference since hydrogen peroxide is used in regeneration processes of waste papers as a pulping agent (col.1, lines 63-68).

10. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Howard (U.S.P.N. 2,593,146) as applied to claim 10 and further in view of Sprang et al (U.S.P.N. 5,571,604).

With respect to claim 14, the Howard reference fails to teach adding antioxidant in combination with the adsorbent to the pulp material; however, the Sprang reference, which is in the art of adding activated carbon to paperboard, teaches that antioxidants to pulp material along with activated carbon (col.2, lines 55-58). Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of the Howard reference by including addition of antioxidants to pulp material as taught by the Sprang reference since antioxidants does not affect the

characteristics of the composition and also enhances its processability (col.2, lines 54-60).

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The Bodendorf (U.S.P.N. 3,149,023) reference and the Parks (U.S.P.N. 5,693,385) teach incorporating a layer of adsorbent within paperboard material. The Hansen (U.S.P.N. 6,207,009) reference teaches applying hydrogen peroxide to paperboard material.
12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MONZER R. CHORBAJI whose telephone number is (571) 272-1271. The examiner can normally be reached on M-F 6:30-3:00.
13. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JOHN KIM can be reached on (571) 272-1142. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.
14. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Monzer R. Chorbaji *MR*
Patent Examiner
AU 1744
08/16/2005

John Kim
JOHN KIM
SUPERVISORY PATENT EXAMINER